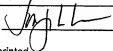



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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 11.020011 (CYM-037)	
I hereby certify that this correspondence (along with any referred to as being attached or enclosed) is being transmitted to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below via the USPTO-EFS-Web filing system. on August 7, 2006		Application Number 10/008,379	Filed 11/05/2001
Signature 		First Named Inventor Garrick Maenle	
Typed or printed Name Jocelyn L. Lee		Art Unit 2872	Examiner Fineman, Lee A.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 42,339</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number</p> <p> Signature Michael J. Bolan Typed or printed name (949) 724-1849 Telephone number August 7, 2006 Date</p>			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:	)	<b>Confirmation No.:</b> 4705
	)	
<b>Garrick Maenle, et al.</b>	)	<b>Group Art Unit:</b> 2872
	)	
<b>Serial No.:</b> 10/008,379	)	<b>Examiner:</b> Fineman, Lee A.
	)	
<b>Filed:</b> November 5, 2001	)	
	)	
<b>For: CYTOLOGICAL AUTOFOCUSING</b>	)	
<b>IMAGING SYSTEMS AND</b>	)	
<b>METHODS</b>	)	

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**ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Washington, D.C. 20231

Dear Sir:

Applicant respectfully requests a pre-appeal brief conference. As an initial matter, an amendment after final has been submitted to this Office on August 3, 2006, correcting minor errors in the claims and specification. Claims 130-144 remain pending in this application. Claims 130-140 and 142-144 stand rejected under 35 U.S.C. §102, as being anticipated by U.S. Patent No. 5,783,814, issued to Fairley et al. ("Fairley"), and claim 141

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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being transmitted to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below via the USPTO EFS-Web filing system.

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Jocelyn L. Lee  
Jocelyn L. Lee

stands rejected under 35 U.S.C. §103, as being obvious over Fairley in view of U.S. Patent No. 5,257,182, issued to Luck et al. ("Luck").

Under 35 U.S.C. §102, to establish a prima facie case of anticipation of claims 130-144 and 142-144, each and every element of these claims must be found in Fairley. Under 35 U.S.C. §103, to establish a prima facie case of obviousness of claim 141, all of the claim limitations must be taught or suggested, and all words in the claim must be considered in judging the patentability of the claim against Fairley in view of Luck.

The pertinent element at issue can be found in independent claim 130, which recites "wherein the performance of at least one of the fine focus actions comprises obtaining images of the slide . . ." In contrast, the fine focus action disclosed in Fairley does not comprise obtaining images. Instead, Fairley discloses a method that performs a fine focus action by transmitting a laser beam to a target and then measuring the magnitude of an electronic focus signal derived from sensed light reflected off of the target, which is to be distinguished from obtaining images in auto-focus operations, as described in the background of Fairley. (See page 5, line 19 to page 15 of Amendment after Final, dated July 6, 2006).

While the Examiner apparently agrees with this distinction, the Examiner has relied instead on the disclosure in Fairley at col. 3, lines 29-35, which essentially states the electronic focus signal derived from the reflected light is used for both focusing and imaging. (See Advisory Action, dated July 20, 2006). However, Fairley further states that "a good image signal is obtained after the auto-focus operations," making it clear that the images of the target are obtained after the auto-focus operation has been completed. That is, the images are not obtained as part of the auto-focus operation, but rather as part of the

actual imaging operation. Thus, it follows that the auto-focus operation performed in Fairley does not comprise obtaining images, as required by independent claim 130. The dependent claims recite additional features that are clearly not disclosed or suggested in Fairley.

For example, claim 135 requires "estimating an in-focus coordinate along the respective focal axis as a function of the coarse in-focus coordinate and a global focal plane." The specification describes one method of determining a global focal plane based on fiducial marks on the slide for providing a guide across the complete cell spot. (See paragraphs [00145]-[00147] and Fig. 29). This global focal plane is then used, in conjunction with the in-focus coordinate determined in the coarse focus action, to estimate an in-focus coordinate during the fine focus action. (See paragraph [00156] and step 282 of Fig. 31).

In concluding that Fairley discloses this element, the Examiner refers to Figs. 6 and 7 and col. 19, lines 29-38 of this reference. Fairley discloses here that before a fine focus operation is performed, a coarse auto-focus operation is used to position the target 112 within +/- 10 microns of the focus position 203. Fairley subsequently describes an iterative fine focus operation, which begins with the in-focus position determined in the coarse auto-focus operation. (See col. 19, line 39 to col. 21, line 10). To the extent that the fine focus operation disclosed in Fairley can be considered as comprising the step of estimating an in-focus coordinate, there is no disclosure in Fairley that such estimation is performed based on a global focal plane.

Dependent claim 138 specifies that the performance of each fine focus action comprises "selecting one of the plurality of coordinates as a fine in-focus coordinate based

on an examination of the images." While Fairley discloses obtaining images after the auto-focus operations, Fairley does not select a fine in-focus coordinate based on an examination of these images—but rather based on a measurement of the magnitude of the electronic signal. Indeed, because the auto-focusing operation is performed before the images are generated, the selection of the fine in-focus coordinate cannot logically be based on an examination of images that do not yet exist.

Thus, Applicant believes that the Examiner has not established a prima facie case that independent claim 130, as well as the claims depending therefrom (claims 131-140 and 142-144), are anticipated by Fairley under 35 U.S.C. §102.

Because Luck does not supplement the failed teachings of Fairley with respect to independent claim 130, the Examiner has not established a prima facie case that claim 141, which depends from claim 130, is obvious over the combination of Fairley and Luck under 35 U.S.C. §103.

#### Conclusion

For the reasons set forth above, Applicant respectfully submits that the currently pending claims are patentable over the cited prior art, and thus, a notice of allowance is respectfully requested.

Respectfully submitted,

**VISTA IP LAW GROUP LLP**

Dated: August 7, 2006

By: 

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